

REMARKS/ARGUMENTS

In the Office Action mailed November 29, 2006, claims 12-18 and 20-31 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

CLAIM OBJECTIONS

Applicant is confused regarding examiner identified mis-numbering of the claims. In the last office action, claims 21- 32 were added. Applicant is unclear as to the mis-numbering of the claims being referred to by the examiner. Therefore, the application refers to the claims herein as originally numbered.

CLAIM REJECTIONS – 35 U.S.C. § 102(a)

The Examiner rejected claims 25-28 under 35 U.S.C. §102(a) as being anticipated over United States Patent No. 5,223,316 to Nemzin *et al.* (Nemzin). Applicant respectfully traverses these rejections. In light of the following remarks, Applicants respectfully submit that these claims are allowable.

Applicant respectfully note that “A claim is anticipated only if each and every element as set forth in the claim is found.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Nemzin does not teach or suggest each and every element of independent claim 25 and its dependant claims (including claims 26-28).

For example, claim 25 recites a combination including: “a base configured to be fixed to in a non-removable manner to a floor or wall.” Support for this amendment can be found in paragraph [0015] of the specification which describes an example of using an adhesive to fix the base to a wall.

In contrast, at best, Nemzin is directed to a sign with a tab or hanging bracket that can hung on a nail or other structure. The easily removable (from the wall) system of Nemzin which may work well for the purpose of the apparatus of Nemzin, it is unsuitable for the present invention. Once the base of the present invention is fixed to a wall or floor, there it will stay, and not be easily knock out of place or removed. Only by using tools, destroying the base or bond of the base to the wall can the base of the present invention be removed.

With respect to claims 26 and 27, not only are they patentable by reason of their dependency, but nowhere in the office action are the limitations of claims 26 and 27 discussed with respect to the prior art, applicant as no reason to believe that the limitations of claims 26 and 27 are found in the prior art. Claim 28 is patentable at least by reason of its dependency. Applicants respectfully request that the rejections of claims 25-28 be removed.

CLAIM REJECTIONS – 35 U.S.C. § 103(a)

The Examiner rejected claims 12-16 and 20, 21, 23 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,280,499 in view of U.S. Patent No. 5,223,316 to Nemzin et al. (hereinafter referred to as “Nemzin”). These rejections are respectfully traversed.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. The recited prior art separately or in combination does not teach or suggest the claimed combination.

For example, claim 12 recites a combination including: “base element being configured to be secured in a non-removable manner to a wall or floor” Support for this amendment can be found in paragraph [0015] of the specification which describes an example of using an adhesive to fix the base to a wall.

Neither Studen nor Nemzin (as discussed above) either separately or in combination teach or suggest the combination recited in claim 12. Claims 13-24 are patent able at least by reason of their dependency on claim 12. Claims 26-32 are patentable at least by reason of their dependency on claim 25.

Further, with respect to claims 30-32 (mentioned by the examiner to be claims 29-31), the examiner states that “the applicant does not disclose the indicia with phosphorescent, glitter, or photo-luminescent solves any stated problem or is for any particular purpose.” Applicant respectfully disagrees. In paragraph [0019] of the specification hazy/smoky and dim lighting conditions and it is asserted that the features recited in claims 30-32 will aid in providing visibility to the signage in such conditions. The features of claims 30-32 are not taught or suggested by the cited prior art. Therefore, applicant requests that the rejections of these claims be removed *even if the base claim upon which they depend is still rejected*.

Claims 12 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright U.S. Patent No. 2,535,619 (“Wright”) in view of Studen. Applicant respectfully traverses this rejection.

The Examiner states on page 6 of the office action, “Wright is adapted to be placed on a table, the examiner contends the toy is also adapted or configured to be placed on a floor.” However, even if the examiner’s contention is correct, Wright does not teach or suggest a combination that includes a “base element being configured to be secured in a non-removable manner to a wall or floor” as recited by claim 12. Claim 18 depends from claim 12, therefore, Applicants respectfully request that the rejection to these claims be removed.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests all the objections and rejections to the specification and claims be removed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1792 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not time filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 15998.0023.

Respectfully submitted,

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